

REMARKS/ARGUMENTS

Prior to entry of this Amendment, the application included claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23. Claim 11 has been amended. No claims have been canceled or added. Hence, after entry of this Amendment, claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23 stand pending for examination.

Claims 1-5, 7, 9, 21 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 7, 9, 11-15, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,397,194 to Houvener et al. (“Houvener”) in view of the cited portions of U.S. Patent Publication No. 2001/0029470 to Schultz et al. (“Schultz”).

Claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz.

Rejections Under 35 U.S.C. § 112

The Applicant respectfully traverses the rejection of claims 1 and 21. According to the Office Action, the claims are rejected because it is not clear what the Applicant means by the term “user-defined category.” The term “user-defined” modifies the word “category.” The words “user” and “defined” are used together as an adjective, hence the hyphen joining the two words. Using the term “user-defined” is similar to saying “first” category,” but the term “user-defined” is used because it provides a better description than “first.” The “category” becomes a “user-defined category” upon “receiving from the consumer computer information that defines at least one user-defined category based on product information” as recited in the claim. The

Office Action is mistaken that the category is already defined. The information received from the consumer computer defines the user-defined category as recited in the claim.

The Office Action also questions whether the user is the same as the consumer. Again, this confusion appears to arise because of a misunderstanding that the term “user” is a noun. As stated above, it is not a noun. The term “user” is joined together with the word “defined” by a hyphen, thereby indicating their use together as an adjective modifying the word “category.” There is no “user” (noun) recited in the claim. Hence, the rejection on this ground appears to be improper.

The Office Action also states that there is no antecedent basis for “the items sorted into categories.” This also appears to be incorrect. Antecedent basis for “the items” may be found in the claim element “receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts.” In this element, the first use of the term “items” provides antecedent basis for later uses of the term “items.” Hence, the rejection on this ground appears to be incorrect. The Applicant, therefore, believes the rejection of claims 1, 2-5, 7, 9, 21 and 23 to be improper.

Claim 11 has been amended to address the 35 U.S.C. § 112 rejection of claims 11-15 and 17.

Rejections Under 35 U.S.C. § 101

The Applicant respectfully traverses the rejection of claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23 under 35 U.S.C. § 101. The Office Action asserts that the claims do not produce a “useful, concrete, and tangible result.” The Applicant respectfully disagrees. The Office Action wisely recites the claim element “transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories comprising the at least one user-defined category based on product information for display at the consumer computer,” but incorrectly concludes that this does not produce a “real-

“world” result. Not true. At the end of the claimed process, an electronic file that previously did not exist at the consumer computer now exists there. The file is useful in that it may be displayed at the consumer computer, thereby providing valuable information for the user. Hence, the rejection of claims 1 and 21 and their dependant claims are believed to be improper.

The Office Action also incorrectly states that the claims merely recite a mathematical algorithm plus data gathering steps. The element “receiving from the consumer computer information that defines at least one user-defined category based on product information” is neither a mathematical algorithm nor a data gathering step. Moreover, the use of the user-defined category in sorting the items further removes the claim from the realm of mathematical algorithm. Hence, the Applicant believes the rejections to be improper.

The apparatus claims are rejected based on the “underlying process.” The Applicant respectfully traverses this rejection in that the processes underlying the apparatus claims are not non-statutory, at least for the reasons stated above.

The Applicant respectfully traverses the 35 U.S.C. § 101 rejection of claim 18. The Office Action asserts that the “means for” elements are software program elements. This is not correct. While the elements may be implemented in software, this is not a requirement. The elements may also be implemented in hardware. Hence, the claims are not inoperative.

Rejections Under 35 U.S.C. § 103(a)

The Applicant respectfully traverses the claim rejections under 35 U.S.C. § 103(a) since the Office Action has not established a *prima facie* case of obviousness. Specifically, the cited references do not teach or suggest all of the claim limitations, one of skill in the art would not be motivated to combine the references, and there is no reasonable expectation that the reference teachings could be combined successfully.

Focusing initially on claim 18, the Office Action does not cite a reference that teaches or suggests “means for categorizing a plurality of items on a receipt into user-definable categories according to the product information.” The Office Action correctly states that neither

Houvener nor Schultz teach or suggest this element. Instead, the Office Action relies on Official Notice for this claim element. The Applicant respectfully traverses this and requests compliance with MPEP § 2144.03 and/or 37 C.F.R. § 1/104(d)(2). The Applicant maintains that claim 18 is allowable.

Claims 1 and 21 recite “receiving from a consumer computer information that defines at least one user-defined category.” The cited references do not teach or suggest this. The Office Action fails to give patentable weight to “information that defines at least one user-defined category.” The Applicant is unaware of any examination guideline that allows this. The Office Action states that it is “non-functional descriptive material because it does not further limit the step of receiving information from the consumer computer.” On the contrary. The information received from the consumer computer “defines at least one user-defined category.” Moreover, the information is later used in sorting the items. The Applicant, therefore, believes that the failure to give the element patentable weight is without merit. And, because the cited references do not teach or suggest this, the Applicant believes that the claims are allowable, at least for this reason.

All claims are believed to be allowable for the additional reason that one of skill in the art would not be motivated to combine the references. Houvener teaches away from Schultz since Houvener requires paper receipts (see Houvener, col. 6, ll. 59-60) and Schultz deals exclusively with electronic environments (see, for example, the Abstract, and paragraphs 3, 10, 29 and 31, among others, of Schultz). Hence, any hint of a motivation to combine the references is destroyed by this teaching away. All pending claims are, therefore, believed to be allowable, at least for this additional reason.

The Applicant respectfully points out that the new grounds of rejection did not render this argument moot. The pending Office Action continues to assert that these references are combinable without addressing the Applicant’s argument against this combination.

Moreover, the cited references could not be successfully combined to produce a working embodiment of the Applicant’s claimed invention. Houvener relates to scanning paper

receipts. Schultz deals exclusively with electronic environments. There is no receipt generated by Schultz to be scanned by Houvener. There being no teaching that allows one to interface with the other, the system produced by the combination would fail to function properly. Hence, all pending claims are believed to be allowable, at least for this additional reason.

Conclusion

In view of the foregoing, the Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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